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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,784	07/31/2001	Jeffry J. Grainger	020313-000510US	4833
20350	7590	09/30/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,784

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 31, 2001.

Claims 1-21 are currently pending in this application.

### ***Information Disclosure Statement***

2. The information disclosure statements (IDSs) submitted on January 7, 2002, March 7, 2003, and August 24, 2004 are being considered by the examiner.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the remote server with a database and the associating steps must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear whether the remote sever and the database are part of the client system or not. It is also not clear how many associating steps are involved. The first associating the document with one or more patent case on the remote server and then the associating the IDS information with an electronic invention disclosure statement for the first patent case. Where does the IDS form come from? How are the documents associated with each other?

How is the IDS document generated?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant uses the abbreviation IDS through out the claim language without first identifying what it means. Generally, the abbreviation IDS stands for information disclosure statement. However, it has been used to stand for invention disclosure statement, also. The applicant uses both terms in the claim language.

The Examiner finds that it is difficult to completely construe the claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections, the claims are construed and the art is applied *as much as practically possible*.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Porcari (US 2001/0037460) (hereinafter referred to as Porcari).

Referring to Claim 1:

Porcari discloses a computer implemented method of generating an information disclosure statement comprising:

receiving a load signal transmitted from a client system to a remote server system ([0045];

loading an electronic document that contains reference information to be disclosed to a patent office from a first database external to the remote server system to a second database on the remote server system, the reference information including information disclosure statement (IDS) information [0056-0057];

associating the electronic document with one or more patent cases on the remote server system [0045] and [0056-0057]; and

receiving a create signal from the client system on the remote server system, the remote server system associating the IDS information with an electronic invention disclosure statement for a first patent case of the one or more patent cases in response to the signal [0045] and [0056-0057].

Referring to Claim 16:

Porcari discloses a computer implemented method of generating an information disclosure statement comprising:

receiving a load signal transmitted from a client system to a remote server system [0015, 0025, 0045];

loading one or more electronic documents that contain reference information to be disclosed to a patent office into a database under control of a first server system, the electronic documents being loaded from a source external to the first server system and the reference information including IDS information [0056-0058];

storing one or more reference links to the one or more electronic documents in a reference table [0056-0058];

linking a first case in a cast table to the one or more reference links [0056-0058];  
and

receiving a signal form the client system of the first server system, the first server system associating the IDS information for each of the one or more electronic documents with an electronic invention disclosure statement for the first case in response to the signal [0045] and [0056-0058].

Referring to Claims 2 and 17:

Porcari discloses wherein the electronic document includes plurality of fields for storing the IDS information, and wherein, in response to the create signal, the remote server system extracts the IDS information from each of the plurality of fields and stores

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the IDS information in a corresponding plurality of fields in the electronic information disclosure statement [0056-0058].

Referring to Claim 3:

Porcari discloses wherein associating the electronic document with one or more patent documents comprises:

storing a reference link to the electronic documents in a reference table [0056-0058];

storing the one or more patent cases in a case number table [0056-0058]; and  
linking each of the one or more patent cases to the reference link in the reference table [0056-0058].

Referring to Claim 4:

Porcari discloses wherein associating the IDS information includes storing the IDS information in the electronic information disclosure statement [0056-0058].

Referring to Claim 5:

Porcari discloses extracting IDS information from the reference information in response to the create signal [0045] and [0056-0058].



Referring to Claim 6:

Porcari discloses wherein the IDS information is extracted from the reference information automatically in response to the signal [0056-0058].

Referring to Claim 7:

Porcari discloses providing a create prompt to the user for generating the create signal [0039] and [0045].

Referring to Claim 8:

Porcari discloses wherein the create prompt comprises an electronic button (Figure 1(14)).

Referring to Claim 9:

Porcari discloses wherein the first database is coupled to the remote server system over a computer network {0024-0026}.

Referring to Claim 10:

Porcari discloses providing access to the electronic information disclosure statement to multiple users over a network [0025].

Referring to Claim 11:

Porcari discloses electronically transmitting the electronic information disclosure statement to a patent office [0009] and [0058].

Referring to Claim 12:

Porcari discloses receiving a signal indicating that an is being electronically filed in a patent office [0054-0055]; and

electronically transmitting the electronic information disclosure statement to the patent office [0009], [0045] and [0058].

Referring to Claims 13-15 and 19-21:

Porcari discloses wherein the electronic document is an electronic version of a United States Patent, a foreign patent document, or an electronic version of a publication [0056-0058].

Referring to Claim 18:

Porcari discloses storing one or more cited reference links to one or more of the electronic documents in a cited reference table, the cited reference links being associated with the electronic documents that have been cited to a patent office [0056-0058];

wherein associating the IDS information comprises associating the IDS information for each of the one or more electronic documents that have reference links in the reference table but do not have cited reference links in the cited reference table

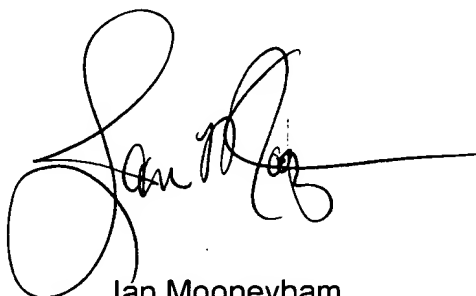
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with an electronic invention disclosure statement for the case in response to the signal [0045] and [0056-0058].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham  
Patent Examiner  
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